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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,739	11/09/2001	Orval Baskerville	1260P01US	5978
26131	7590	03/10/2004	EXAMINER	
NORMAN M. CAMERON SUITE 1401 - 1166 ALBERNI STREET VANCOUVER, BC V6E 3Z3 CANADA			NI, SUHAN	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/986,739

Applicant(s)

BASKERVILLE, ORVAL

Examiner

Suhan Ni

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This communication is responsive to the amendment filed 12/31/2003.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (U. S. Pat. - 3,368,644).

Regarding claims 1-4 and, Henderson discloses an earpiece of a communication device, comprising: an earpiece having a tubular member (18) shaped to fit an ear canal; and a tubular filter (40, 50) having at least two sections, wherein each of sections has a different diameter as claimed.

Regarding claim 5, Henderson further discloses the communication device, wherein the at least one of the sections has a conical configuration (Figs. (2-7) as claimed.

Regarding claims 7-9, Henderson further discloses the communication device, wherein a connector (28) of the earpiece is connected to the conduit (16) as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6 and 10-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson (U. S. Pat. - 3,368,644).

Regarding claims 21, 23 and 43, Henderson discloses a communication device, comprising: an earpiece having a tubular member (18) shaped to fit an ear canal, and a tubular filter (40, 50) having a plurality of sections, each section having different diameter; an acoustic conduit (16) connected to the earpiece; and a chamber member (10) housing a miniature speaker (12) therein. But Henderson does not clearly teach a radio plug as claimed. Since providing a suitable means to connect the communication device to a radio is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to be motivated to provide a suitable mean, such as a radio plug or a wireless connecting means for the communication device, in order to allow the user to hear directly or non-directly from a radio.

Regarding claim 22, Henderson further discloses the communication device, wherein the conduit is a flexible tube (16) as claimed.

Regarding claims 6 and 24-25, Henderson further discloses the communication device, wherein the at least one of the sections has a conical configuration. But Henderson does not clearly teach a 30-degree conical configuration as claimed. Since Henderson does not specially restrict the angle of conical configuration, it therefore would have been obvious to one skilled in the art at the time the invention was made to be motivated to provide a suitable angle, such as 30-

degree, for the conical section of the of the device, in order to provide a comfortable earpiece for different user.

Regarding claims 26-27, Henderson further discloses the communication device, wherein the first section (46) of the filter is narrower than the member as claimed.

Regarding claims 28-30 and 42, Henderson further discloses the communication device, wherein a connector (28) of the earpiece is connected to the conduit (16) as claimed.

Regarding claims 10-19, 31-40 and 44-49, Henderson does not clearly teach a specific dimension of each element as claimed. Since Henderson does not specially restrict all the dimensions of the device, it therefore would have been obvious to one skilled in the art at the time the invention was made to be motivated to provide a suitable configuration, such as 0.3 mm for the diameter of the second section, for each element of the communication device, in order to provide a desirable, especially comfortable earpiece for each of different users.

Regarding claims 20 and 41, Henderson does not clearly teach a silicon material for making the device as claimed. Since providing a silicon housing for hearing device is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to be motivated to provide a suitable material, such as silicon, for the member of the communication device, in order to provide a desirable, especially comfortable earpiece for each of different users.

#### ***Response to Amendment***

4. Applicant's arguments dated 12/31/2003 have been fully considered, but they are not deemed to be persuasive.

The cited reference (U. S. Pat. - 3,368,644) does clearly show that an earpiece of a communication device, comprising: an earpiece having a tubular member (18) shaped to fit an ear canal; and a tubular filter (40, 50) having at least two sections, wherein each of sections has a different diameter as claimed at in claim 1.

Regarding the applicant's remarks/arguments, the examiner respectively disagrees with the applicant. Please see the examples as the following:

A person having average skill in the art will clearly see and understand that a hearing device is one of kind communication device, which comprises a plurality of communication elements, such as a communications earpiece as claimed.

Furthermore, in response to applicant's arguments, the recitation "communication earpiece" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In line 4 of page 16, the applicant agrees with "the vent of the earpiece is restricted in an attempt to modify frequency", which clearly indicates the function of an acoustic filter as claimed.

In lines 18-19 of page 16, the applicant states that the cited reference lacks teaching of "electronic interface" as claimed. Again, the examiner respectively disagrees with the applicant. The cited reference clearly teaches at least one electronic interface (12).

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Regarding claims 6 and 10-49, the applicant argues no motivation to combine the references. It is not necessary that the references actually suggest, expressly or in so many words the changes or improvements that applicants have made. The test for combining references is what the references as whole would have suggested to one of ordinary skilled in the art. **In re Sheckler, 168 USPQ 716 (CCPA 1971); In re Mlaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 715 (CCPA 1968).**

Method claims 43-49 are similar to claims 1-42 except for being couched in method terminology; such methods would be inherent when the structure is shown in the references.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any response to this final action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

Or faxed to:

**(703) 308-9051, (for formal communications; please mark "EXPEDITED  
PROCEDURE"), or**

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**(703) 305-9508**, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

**Receptionist, Sixth Floor,  
Crystal Park II,  
2121 Crystal Drive,  
Arlington, Virginia 22202**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Suhan Ni** whose telephone number is **(703)-308-9322**, and the number for fax machine is **(703)-305-9508**. The examiner can normally be reached on Monday through Thursday from 9:00 am to 7:30 pm. If it is necessary, the examiner's supervisor, **Curtis Kuntz**, can be reached at **(703) 305-4708**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is **(703) 305-3900**.

SN

March 6, 2004

  
**CURTIS KUNTZ**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600